

REMARKS

I. Introduction

Applicants appreciate the indication of allowable subject matter recited in claims 44 and 57.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 42, 43, 45, 48-50 And 52-55 Under 35 U.S.C. § 103

Claims 42, 43, 45, 48-50 and 52-55 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Shigehiro et al. (USP No. 6,741,387) in view of Aoki et al. (USP No. 6,777,872). Applicants respectfully traverse the above cited rejection for at least the following reasons.

With regard to the present invention, claim 42 recites, in-part, a display device comprising: a pair of substrates disposed opposite to each other, at least one of which is transparent; a plurality of particles having an electrostatic property contained in a gaseous phase provided between the pair of substrates; first and second electrodes provided for each of pixels arranged in a matrix for driving the particles... and when voltage is applied to the first and second electrodes by a voltage applying portion, the particles are caused to travel between the first and second electrodes in accordance with the voltage applied so as to display an image corresponding to the image signal.

It was alleged in the pending Office Action that the combination of Aoki and Shigehiro renders claim 42 of the present invention obvious because “it would have been obvious to one

having ordinary skill in the art...to combine the device of Shigehiro et al. with the parent particles of Aoki et al. for the purpose of displaying an image.”

However, Applicants respectfully submit that the combination of Shigehiro and Aoki is improper. The device of Shigehiro uses conductive particles to form images by moving the charged particles across substrates in a display element. It is alleged that Aoki discloses particles each comprising a parent core and a plurality of child particles fixed to the parent particle. However, the particles disclosed in Aoki form a part of the surface of the electrodes, and are not particles for use in the gaseous phase provided between the pair of substrates. Aoki recites in col. 15, “the silver electrodes are formed using Ag particles whose surfaces are each coated with a metal or metal oxide.” (lines 26-28). Aoki further states “the silver electrodes formed as described above each have such a construction...in which Ag particles each covered with a metal or a metal oxide layer are sintered with the glass frit” (lines 36-39). Thus, the particles disclosed in Aoki are permanently fused onto the surface of the electrodes, and as such, neither have an electrostatic property, nor are they provided in the gaseous phase. As a result of these particles being fused to the surface, it is clear that the particles would be quite unable to travel between the substrates when a voltage is applied.

Accordingly, the particles of Aoki would not be useful in the application of the invention of Shigehiro and would render the invention of Shigehiro inoperable. As is well known in patent law, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As the use of the particles of Aoki cannot be utilized to obtain the desired result of forming an image in the device of Shigehiro, Applicants respectfully submit that the proposed combination is

improper because there is no suggestion or motivation to make the proposed modification. Thus, the combination of Shigehiro and Aoki fail to disclose a display device having a plurality of particles having an electrostatic property contained in a gaseous phase provided between the pair of substrates, which are caused to travel between the first and second electrodes in accordance with the voltage applied so as to display an image corresponding to the image signal.

Accordingly, it is respectfully requested that the § 103 rejection of claim 42, and any pending claims dependent thereon be withdrawn.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 42 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

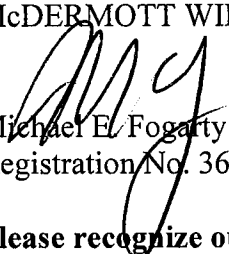
Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

Application No.: 10/695,669

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/NDM:kap
Facsimile: 202.756.8087
Date: May 5, 2008

**Please recognize our Customer No. 53080
as our correspondence address.**